



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,845	02/14/2001	Rupesh Kapoor	2941P001C2	3223

8791 7590 01/26/2004

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD, SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER

HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
----------	--------------

2142

DATE MAILED: 01/26/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,845

Applicant(s)

KAPOOR, RUPESH

Examiner

Robert B. Harrell

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/14/01 et seq.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *See attached Office Action.*

Serial Number: 09/783,845

Art Unit : 2142

1. Claims 1-22 are presented for examination.
2. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based on 35 U.S.C 101.
3. Claims 1-20 of this application are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of prior U.S. Patent No. 6,205,489. This is a double patenting rejection for the reasons outline below.
4. Claim 1 of this application is identical to claim 11 of the patent. Furthermore, provided below is a map of the claims of this application (on the left) followed to the claims of the patent (on the right) which are also identical:
 - a) 2 to 12;
 - b) 3 to 13;
 - c) 4 to 14;
 - d) 5 to 15;
 - e) 6 to 16;
 - f) 7 to 1;
 - g) 8 to 2;
 - h) 9 to 3;
 - i) 10 to 8;
 - j) 11 to 4;
 - k) 12 to 5;
 - l) 13 to 6;
 - m) 14 to 7;
 - n) 15 to 9;
 - o) 16 to 10;
 - p) 17 to 17;
 - q) 18 to 18;
 - r) 19 to 19;
 - s) 20 to 20.
5. The following non-statutory double patenting rejections are based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In

Serial Number: 09/783,845
Art Unit : 2142

re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

6. A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (c) may be used to overcome an actual or provisional rejection based on a non-statutory based double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

7. Claims 21 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 11 and 17 of U.S. Patent No 6,205,489. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons outlined below.

8. Although the wording between the claimed subject matter of this application and those of the patented claim are not identical, the claimed subject matter of this application encompasses the scope of the patented claims. Since claims 21 and 22 do not teach or define above claims 1, ~~11~~, and 17, in this application which have been shown to be those of claims 1-20 of the patent, claims 21 and 22 are obvious over claims 1, 11, and 17 of the patent. A test for double patenting is if the application claims literally infringe on the patent claims, as is in this case.

9. Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No 5,884,038. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons outlined below.

10. Although the wording between the claimed subject matter of

Serial Number: 09/783,845
Art Unit : 2142

this application and those of the patented claim are not identical, the claimed subject matter of this application encompasses the scope of the patented claims. Claim ¹11 of the patent is identical to claim 1 of this application but with the added words of "to the first one of the plurality of clients" between the words "returning" and "the IP address of the first one of plurality of servers". Also, claim ¹11 of the patent is identical to claim 1 of this application but with the added words of "to the plurality of clients" between the words "returned" and "is proportional to a relative weight of the first one of the plurality of servers". Thus claim ¹11 of the patent is claim 1 of this application with added limitations thus making claim 1 of this application broader in scope than that of claim 11 of the patent. A test for double patenting is if the application claims literally infringe on the patent claims, as is in this case. As for the dependent claims, they each map correspondingly to each other between this application and the patent. The other independent claims of this application infringe those of the patent claims as do the dependent claims.

11. Furthermore, provided below is a map of the claims of this application (on the left) which encompass the claims of the patent as listed to the right:

Serial Number: 09/783,845
Art Unit : 2142

- a) 2 to 2;
- b) 3 to 3;
- c) 4 to 4;
- d) 5 to 5;
- e) 6 to 6;
- f) 7 to 7;
- g) 8 to 8;
- h) 9 to 9;
- i) 10 to 10;
- j) 11 to 11;
- k) 12 to 12;
- l) 13 to 13;
- m) 14 to 14;
- n) 15 to 15;
- o) 16 to 16;
- p) 17 to 17;
- q) 18 to 18;
- r) 19 to 19;
- s) 20 to 20.
- t) 21 to 1,11, and 17;
- u) 22 to 1,11, and 17.

12. The claims are allowable over the art of record because the art of record does not teach or remotely suggest a method in an Internet domain name server which balances the load of resolving domain names to IP addresses as currently claimed.

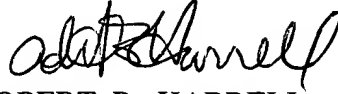
13. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (703) 308-9705. The fax phone numbers for the Group are (703) 746-7238 for After-Final, (703) 746-7239 for Official Papers, and (703) 746-7240 for Non-Official and Draft papers.

Serial Number: 09/783,845
Art Unit : 2142

16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142